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UNITED STATES PATENT AND TRADEMARK OFFICE

JAN 5 2001

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 2023
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In re

DECISION ON
PETITION FOR REGRADE
UNDER 37 C.F.R. § 10.7(c)

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 11, 18 and 48 of the morning section, and questions 10, 16 and 28 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On July 26, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 11, 18 and 48, and afternoon questions 10, 16 and 28. Petitioner's arguments for these questions are addressed individually below.

Morning question 11 reads as follows:

Please answer questions 10 and 11 based on the following facts. Mario Lepieux was a member of a Canadian national hockey team touring Europe. While travelling through Germany (a WTO member country) in December 1998, Mario conceived of an aerodynamic design for a hockey helmet that offered players improved protection while reducing air resistance during skating. Upon Mario's return to Canada (a NAFTA country), he enlisted his brothers Luigi and Pepe Lepieux to help him market the product under the tradename "Wing Cap." On February 1, 1999, without Mario's knowledge or permission, Luigi anonymously published a promotional article written by Mario and fully disclosing how the Wing Cap was made and used. The promotional article was published in Moose Jaw Monthly, a regional Canadian magazine that is not distributed in the United States. The Wing Cap was first reduced to practice on March 17, 1999. A United States patent application properly naming Mario as the sole inventor was filed September 17, 1999. That application has now been rejected as being anticipated by the Moose Jaw Monthly article.

11. Which of the following statements is most correct?

- (A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.
- (B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.
- (C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.
- (D) (A) and (C).
- (E) (A), (B), and (C)

The model answer is choice (E), which includes (A), (B) and (C). Mario can rely on his activities in both (A) Canada (a NAFTA country) and (B) Germany (a WTO member country) in establishing a date of invention in a priority contest against another inventor. Mario can also rely on his activities in Canada (a NAFTA country) in establishing a date of invention prior to publication of the regional Canadian magazine article (choice (C)).

Petitioner argues that choice (C) is incorrect, and thus choice (E) is incorrect, so that both choices (A) and (B) should be given credit. Petitioner argues that since the invention was not reduced to practice until March 17, 1999, Mario cannot rely on his activities in Canada prior to

the February 1, 1999 publishing date of the magazine article to establish a prior date of invention. Petitioner argues that since invention requires both conception and reduction to practice, Mario cannot establish a date of invention prior to the actual reduction to practice.

Petitioner's arguments have been fully considered but they are not persuasive. While the reduction to practice occurred after the date of publication of the article, Mario may rely on his activities in Canada in establishing his date of invention by showing conception and due diligence prior to the date of publication of the article. See 37 CFR 1.131 and MPEP § 715 and § 715.07. Since, the article is a publication of Mario's own work and not a statutory bar, he may rely on his activities in Canada. See 35 U.S.C. § 104 and MPEP § 715.01(c) and § 715.07(c).

Morning question 18 reads as follows:

18. Which of the following is NOT a policy underlying the public use bar of 35 U.S.C. § 102(b)?

- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
- (B) Favoring the prompt and widespread disclosure of inventions.
- (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
- (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
- (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

The model answer is choice (D). Increasing the economic value of a patent by extending the effective term of the patent up to one year is not a policy underlying the public use bar of 35 U.S.C. 102(b).

Petitioner argues that the most correct answer is choice (C). Petitioner argues that since the question refers to policy underlying the "public use" bar of 35 U.S.C. 102(b), choice (C), which refers only to "sales activity", cannot constitute an underlying policy.

Petitioner's arguments have been fully considered but they are not persuasive. The Court of Appeals for the Federal Circuit has repeatedly stated that one of the policies underlying the public use bar of 35 U.S.C. 102(b) is allowing inventors a reasonable amount of time following sales activities to determine the potential economic value of a patent. Note *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996); *Tone Brothers v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994); and *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 226 USPQ 402 (Fed. Cir. 1985). The Federal Circuit lists all of the answer choices, with the exception of choice (D) (i.e. increasing the economic value of a patent by extending the effective term of the patent up to one year) as policies underlying the public use bar of 35 U.S.C. 102(b).

Morning question 48 reads as follows:

48. Kevin invents a solar energy device for cooking food having a parabolic reflector with a rod connected along the center axis of the reflector, and a cooking grill connected to the top of the rod. A thorough search of the prior art results in locating Bill's United States patent, issued July 22, 1997. Bill's patent discloses a parabolic reflector having a cut-out portion from the base of the reflector with a rod connected along the center axis of the reflector, and a grill for cooking connected to the top of rod. Figures in Bill's patent show the invention with (Fig. 2) and without (Fig. 1) the cut-out portion, respectively. Bill's patent specifically teaches away from making the device by omitting the cut-out portion because the base portion of the reflector would unnecessarily gather fat and grease when the device is used to cook meat. On July 1, 1998, you, a registered practitioner, discuss the patent with Kevin, who states that his invention would be advantageous, since by leaving out the cut-out portion, the invention could be used to collect fat and grease, which could be sold. On July 20, 1998, you file a patent application for Kevin disclosing the solar energy device and its advantages, and claiming the device. During examination of the application, an examiner finds a publication disclosing a solar energy cooking device having a reflector without a cut-out portion. Which of the following accurately describes the duty to disclose Bill's patent to the PTO?

- (A) Only you have a duty to disclose the patent to the PTO.
- (B) Both you and Kevin have a duty to disclose the patent to the PTO, but the disclosure need not be in writing.
- (C) Both you and Kevin have a duty to disclose the patent to the PTO, and the disclosure must be in writing.
- (D) There is no duty to disclose the patent to the PTO, since it is a United States patent, and the examiners already independently have access to electronically search the database with all the United States patents.
- (E) There is no duty to disclose the patent to the PTO, because the patent is not material to patentability since it teaches away from the inventive concept of Kevin's invention.

The model answer is choice is (C). Both the practitioner and Kevin have a duty to disclose the patent to the PTO, and the disclosure must be in writing.

Petitioner argues that the most correct answer is choice (A). Petitioner argues that choice (C) is incorrect because it requires both the practitioner and Kevin to discharge their duty to disclose by each making separate written disclosures to the PTO. Petitioner acknowledges that "both the registered practitioner and Kevin have a duty to disclose Bill's patent", but goes on to argue that since only a single disclosure is necessary, choice (A) is the most correct answer.

Petitioner's arguments have been fully considered but they are not persuasive. Contrary to petitioner's contention, choice (C) does not require duplicate written disclosures. It merely states that both the practitioner and Kevin have a duty to disclose the patent to the PTO, and that the disclosure must be in writing. It does not state that both must make separate written disclosures. Choice (A) is clearly incorrect, since it states that only the practitioner has a duty to disclose the patent to the PTO. Petitioner has acknowledged that "both the registered practitioner and Kevin have a duty to disclose Bill's patent." Also see 37 CFR 1.56. Thus, choice (A) is not a true statement.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice (B). Sam should do nothing, and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2-10 is confirmed.

Petitioner argues that the most correct answer is choice (E). Petitioner argues that while choice (B) is an appropriate course of action, the letter described in choice (E) is equally or more correct, and that it will result in the same outcome as choice (B) if the client does not submit payment in advance in response to the letter.

Petitioner's arguments have been fully considered but they are not persuasive. The letter described in choice (E) would not be a proper course of action because Sam must first request to withdraw and obtain permission from the PTO in accordance with 37 CFR 10.40 and MPEP 402.06. Further, Sam has been told by his client that they do not have funds to continue prosecution. If Sam does nothing, a Reexamination Certificate will issue confirming the patentability of dependent claims 2-10. See MPEP §§ 2287 and 2288. Since Sam agrees with the propriety of the rejection of claim 1, the client is not prejudiced, nor is it adversely affected. The facts state that Sam received the Office action, agreed with the Examiner that claim 1 is unpatentable over the Russian patent and forwarded it to his client. The client then advised Sam that they have no funds available to further prosecute the reexamination proceeding. Thus, the client is aware of the office action and Sam's agreement with the Examiner. Choice (E) is improper because the letter states that Sam will take no further action in the proceeding and file no papers with the PTO unless he is paid, however, no further action or filing is necessary on the part of Sam. No papers need to be filed with the PTO to preserve the client's rights, so Sam should not be charging the client or withdrawing if no advanced payment is made.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a

number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B). Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

Petitioner argues that the most correct answer is choice (E), because (A), (B), (C) and (D) are each incorrect. Petitioner argues that none of the statements regarding the relevance of "nearly simultaneous invention" by Debbie and Billie are correct. Petitioner asserts that since MPEP 2141.03 does not refer to "nearly simultaneous invention" as being evidence of the level of skill in the art, choice (B) is not correct. Petitioner further argues that since the MPEP, PCT, U.S. patent statutes, patent rules, and case law (listed in the examination instructions) do not

refer to "nearly simultaneous invention", choices (A), (B), (C) and (D) are incorrect.

Petitioner's arguments have been fully considered but they are not persuasive. In *International Glass Co. v. U.S.*, 159 USPQ 434 (US Cl Ct 1968), the court stated at 442, "[t]he fact of near simultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art." The court in *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986) stated at 380, "[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of 'the level of knowledge in the art at the time the invention was made.' *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983)." The court in *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998) noted at 1983, "the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art", referring to *Merck*. Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention, rendering the statement in answer (B) correct. Therefore, choice (E) is incorrect.

Afternoon question 28 reads as follows:

28. Which of the following is true?

- (A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.
- (B) The 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is extendable under 37 CFR 1.136(a).
- (C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.
- (D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.

(E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice (E). When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

Petitioner argues that the most correct answer is choice (A). Petitioner argues that choice (E) is incorrect because the claim for foreign priority could be made in a supplemental reissue oath or declaration, or by way of certificate of correction. Petitioner argues that choice (A) is correct because pointing out differences in what the claims cover could be part of arguing claims separately.

Petitioner's arguments have been fully considered but they are not persuasive. In regard to choice (E), see MPEP 1414 Content of Reissue Oath/Declaration and 37 CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority. Further, note that including a claim for foreign priority in a "supplemental" reissue oath or declaration would be encompassed by choice (E). In other words, including a claim for foreign priority in a "supplemental" reissue oath or declaration is including it in the composite reissue oath or declaration, and it is not clear what distinction petitioner is attempting to make between the two. Further, certificate of correction practice is only relevant after a patent issues. Choice (E) refers to claiming foreign priority in a reissue application, not in an issued patent. When desiring to claim foreign priority in a reissue application, the reissue oath or declaration must include the claim foreign priority.

Choice (A) is incorrect. Appealed claims do not stand or fall separately as a result of

appellant pointing out differences in what the claims cover. 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 CFR 1.192(c)(8) why each claim is separately patentable. Merely pointing out differences in what the claims cover is not argument why the claims are separately patentable. See 37 CFR 1.192(c)(7) and MPEP 1206.

No error in grading has been shown as to morning questions 11, 18 and 48, and afternoon questions 10, 16 and 28. Petitioner's request for credit on these questions is denied.

The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr. Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.)

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy